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PATENT AND TRADEMARK OFFICE**

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Patent Public Advisory Committee Quarterly Meeting

Patent Examination Policy Update

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Subject Matter Eligibility Update

- Judicial developments
- Next steps

Supreme Court Petitions (Pending)

- ***Synopsys, Inc. v. Mentor Graphics Corp.***
 - Whether the § 101 inquiry requires courts to ignore the specification, as the Federal Circuit held, or whether courts should ascertain the true scope of the claims in light of the specification and intrinsic record in determining whether they are drawn to a patent-ineligible concept.
 - Whether an otherwise revolutionary technological breakthrough is not an “inventive concept” under the second step of *Alice* merely because the court believed the breakthrough could theoretically be implemented without a computer.

Supreme Court Petitions (Denied)

- *Affinity Labs v. Amazon.com*
- *Affinity Labs v. DirecTV*
- *Appistry, LLC v. Amazon.com*
- *Blue Spike, LLC v. Google, Inc.*
- *Broadband iTV v. Hawaiian Telcom*
- *Coffelt v. NVIDIA*
- *Concaten v. AmeriTrack Fleet Solutions*
- *DataTreasury Corp. v. Fidelity Nat'l Information Services*
- *TDE Petroleum Data Solutions, Inc. v. AKM Enterprise, Inc.*

Federal Circuit En Banc Petitions (Pending)

- ***GoDaddy.com v. RPost Communications***

- Whether patent eligibility under 35 U.S.C. §101 may be raised as an invalidity defense in a patent litigation even though it is not codified as a defense in 35 U.S.C. §282(b)?
- Whether using the heart-of-the-claims is an improper way to determine whether the claims are directed to an abstract idea under *Mayo/Alice* step one?
- In considering a motion for summary judgment of ineligibility, whether a district court must consider extrinsic evidence regarding whether the challenged claims recite an inventive concept under *Mayo/Alice* step two and whether the district court must construe that evidence in the non-movant's favor?

- ***Prism Tech. v. T-Mobile USA***

- Whether the Federal Circuit must review for clear error a district court's underlying factual findings regarding § 101 patent eligibility under the Supreme Court's precedent in *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831 (2015) and this Court's rulings in *Mintz v. Dietz & Watson, Inc.*, 679 F.3d 1372 (Fed. Cir. 2012) and *Alfred E. Mann Found. for Sci. Research v. Cochlear Corp.*, 841 F.3d 1334, 1341 (Fed. Cir. 2016).

- ***RecogniCorp v. Nintendo Co.***

- Whether patents which involve encoding or decoding of data categorically fail the first step of the *Alice* test for subject matter eligibility?
- Whether novel mathematical limitations are categorically excluded from constituting inventive concepts under the second step of the *Alice* test?
- Whether patents that recite improved methods for encoding data on a computer by reducing the required memory and bandwidth using novel mathematical processes are categorically excluded from patent protection?

Federal Circuit Decisions

- Precedential

- *Intellectual Ventures I LLC v. Erie Indemnity Co.* (March 7, 2017)
- *Intellectual Ventures I LLC v. Capital One Financial Corp.* (March 7, 2017)
- ***Thales Visionix Inc. v. United States*** (March 8, 2017)
- *Mentor Graphics Corp. v. EVE-USA, Inc.* (March 16, 2017) – Step 1 decision
- *Recognicorp, LLC v. Nintendo Co., Ltd.* (April 28, 2017)
- *Credit Acceptance Corp. v. Westlake Svcs.* (June 9, 2017)
- *Cleveland Clinic Foundation v. True Health Diagnostics* (June 16, 2017)

- Non-Precedential

- *Smartflash LLC v. Apple Inc.* (March 1, 2017)
- *In re Salwan* (March 13, 2017)
- *Coffelt v. NVIDIA Corp.* (March 15, 2017)
- *Clarilogic, Inc. v. FormFree Holdings Corp.* (March 15, 2017)
- *West View Research, LLC v. Audi AG* (April 19, 2017)
- *Easyweb Innovations, LLC v. Twitter, Inc.* (May 12, 2017)
- *Prism Technologies LLC v. T-Mobile USA, Inc.* (June 23, 2017)
- *Audatex North America, Inc. v. Mitchell International, Inc.* (July 27, 2017)

- Rule 36 Decisions

- *AthenaHealth v. CareCloud Corp.* (March 10, 2017)
- *Network Apparel Group v. Airwave Networks* (March 13, 2017)
- *Nextpoint, Inc. v. Hewlett-Packard Co.* (March 14, 2017)
- *eResearchTechnology v. CRF, Inc.* (March 17, 2017)
- *Open Parking, LLC v. ParkMe, Inc.* (April 6, 2017)
- *SkillSurvey, Inc. v. Checkster LLC* (April 6, 2017)
- *White Knuckle Gaming, LLC v. Electronic Arts* (April 6, 2017)
- *Williamson v. Citrix Systems, Inc.* (April 7, 2017)
- *Integrated Claims Systems, LLC v. Travelers Lloyds of Texas Insurance Co.* (April 11, 2017)
- *Papst Licensing GmbH v. Xilinx, Inc.* (April 12, 2017)
- *Preservation Wellness Techs. LLC v. Allscripts Healthcare Solutions Inc.* (April 12, 2017)
- *GoDaddy.com, LLC v. RPost Communications Ltd.* (May 5, 2017)
- *NexusCard, Inc. v. Kroger Co.* (May 9, 2017)
- *Linkgine, Inc. v. VigLink, Inc.* (May 11, 2017)

Thales Visionix v. United States

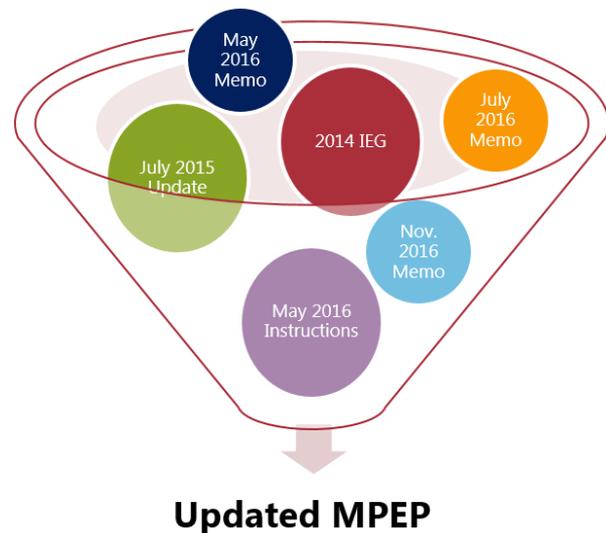
- Claims were **eligible** because they were not directed to an abstract idea (Step 2A inquiry in Office guidance)
 - The claims recite methods and systems of inertial motion tracking, *e.g.*, a system comprising two inertial sensors, and an element that receives and processes the signals “to determine an orientation of the object relative to the moving reference frame based on the signals received from the first and second inertial sensors.”
 - The court found that while the claims utilize mathematical equations to determine the orientation of the object relative to the moving reference frame, the claims are not directed to those equations. Instead, the “claims are directed to systems and methods that use inertial sensors in a non-conventional manner to reduce errors in measuring the relative position and orientation of a moving object on a moving reference frame.”
- Other notable points
 - This case is a reminder that involvement of an exception (such as a math formula) does not “doom the claims to abstraction”.

Patent Eligible Subject Matter Report

- Report on views and recommendations from the public posted on July 25, 2017
- Federal Register notice published October 17, 2016
- December 5, 2016 Roundtable: Exploring the Legal Contours of Patent Eligible Subject Matter
 - Held at Stanford University, with remote participation available at regional offices
 - Facilitate broader legal discussion on the contours of patentable subject matter
- Report and related materials available at
 - <https://www.uspto.gov/patent/initiatives/patent-subject-matter-eligibility-roundtable-2>

Next Steps

- Continue to monitor judicial developments
- Revision to the MPEP incorporating the Office's current subject matter eligibility guidance
- Continue training to reinforce legal principles and improve consistency
- Ongoing public comment period



Questions and Comments

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